

REMARKS

The specification has been amended to delete reference to an earlier application which was incorrectly referred in the present application.

In telephone conferences with Examiner Davis on November 6, 2003, the Examiner's indication of allowable subject matter and prior art references were discussed.

In further examination of the claims, the Applicants have noted that the first and second instruments set forth in the claims do not correspond to the description set forth in the specification. Accordingly, to eliminate this confusion, the Applicants herewith present new independent claims 28-31.

In addition, the independent claims now define the invention as including a sleeveless, or unsleeved, needle which is capable of being inserted through a wound opening of less than about 2 mm. Support for this amendment appears in the original specification on page 6, specifically in the paragraph beginning at line 13. The Applicants submit that none of the references relied on by the Examiner teach or suggest the use of an unsleeved needle capable of being inserted through a wound opening of less than 2 mm.

With specific reference to the Office Action mailed August 28, 2003, the Examiner has rejected claims 22-27 under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention.

The present amendment to the claims overcomes this rejection.

Claims 1, 3, 4, 15, 17, 18 and 20 have been rejected by the Examiner under 35 USC 102(b) as being anticipated by U.S. 5,569,279 to Rainin. In this rejection, the Examiner states that Rainin discloses an instrument for the removal of lens tissue for comprising a first instrument and a second instrument having a tool and a port comprising a distal end of the second instrument. The second instrument comprises a conduit attached to a shaft on the tip of the second instrument as transverse to the shaft and is generally in the shape of a hook. However, Rainin provides no teaching or suggestion of the use of a needle having a diameter enabling insertion through a wound opening of less than 2 mm. Accordingly, the rejection of the cited claims under 35 USC 102(b) is not sustainable and the Examiner is respectfully request to withdraw this rejection.

Claims 5 and 9 have been rejected by the Examiner under 35 USC 103(a) as being unpatentable over Rainin in view of U.S. 5,562,640 to McCabe. In this rejection, the Examiner states that Rainin fails to disclose a plurality of irrigation ports in the irrigation instrument and accordingly reaches to McCabe as a teaching of the use of a general surgical instrument used in irrigating and aspirating a surgical site.

The Examiner acknowledges that the instrument of McCabe is a general surgical instrument and is silent regarding the application to cataract surgery. Nonetheless, the Examiner concludes that one of ordinary skill in the art of

irrigating and aspirating would look to the general surgical art to more efficiently irrigate during cataract surgery. However, McCabe does not teach the use of two instruments and further the use of a vibrated unsleeved needle capable of being inserted into a wound opening of less than 22 mm. Accordingly, the McCabe, et al. reference basically teaches away from the present invention and certainly has no bearing on the structure of the present invention which enables small wound openings.

The Applicants submit that the only incentive for the miniaturization of the McCabe, et al. teachings is through the use of the Applicants own disclosure. The Applicants submit that a rejection based on 35 USC 103 must rest on factual basis and the facts must be interpreted without hindsight reconstruction of the invention. In re Warner and Warner, 154 USPQ 173 (CCPA 1967).

The Applicants further submit that the test for obviousness is not to ask what competent inventors did or would have done to solve the problem. Inventors are by definition inventive. The classical touchstone for obviousness is the technician skilled in the art but having no scintilla or inventiveness or imagination; a paragon of deduction and dexterity, wholly devoid of intuition; a triumph of the left hemisphere over the right.

The question to be asked is whether this mythical creature would in light of the state of the art and of common general knowledge at the date of the invention come directly and without difficulty to the solution taught by

the patent application without relying on the patent application itself.

Accordingly, the Applicants submit that the Examiner has not made a prima facie case of obviousness for claims 5 and 9 under 35 USC 103(a).

Claims 8, 10, 11 and 13 have been rejected by the Examiner under 35 USC 103(a) as being unpatentable over Rainin in view of Evvard. In this rejection, the Examiner states that Rainin is silent regarding the use of an ultrasonic vibration and therefore looks to Evvard. The Applicants submit that this combination of references does not teach the use of two instruments which includes one having a sleeveless vibrated needle capable of being inserted into a wound opening of less than about 2 mm.

Claim 12 has been separately rejected by the Examiner under 35 USC 103(a) as being unpatentable over Rainin in view of Evvard and further in view of McCabe. The Examiner states that the Rainin/Evard device fails to disclose multiple holes and reaches to McCabe for such a teaching. The Applicants reiterate the hereinabove noted arguments with regard to the unsleeved needle and multiple instruments and submit that the case of obviousness has not made.

In view of the arguments hereinabove set forth and amendment to the claims and specification, it is submitted that each of the claims now in the application define patentable subject matter not anticipated by the art of record and not obvious to one skilled in this field who is

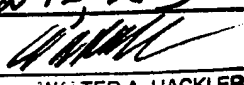
aware of the references of record. Reconsideration and allowance are respectively requested.

Respectfully submitted,



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